UNITED STA[illegible] DEPARTMENT OF COMMERCE
Patent and T[illegible]ademark Office

[illegible]	[illegible]	[illegible]	[illegible]

[illegible]

[illegible]	[illegible]

DATE MAILED:

04/26/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on Mar 21st & 6/13

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 27-57 is/are pending in the application.

[illegible]

Claim(s) [illegible] is/are allowed.

X Claim(s) 27-57 is/are rejected.

Claim(s) [illegible] is/are objected to.

Claims [illegible] are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on [illegible] is/are objected to by the Examiner.

The proposed drawing correction, filed on [illegible] is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under [illegible].

All Some* None of the CERTIFIED copies of the priority documents have been

received.

[illegible]

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

Acknowledgement is made of [illegible].

Attachment(s)

Notice of References Cited, PTO-892

X Information Disclosure Statement(s), PTO-1449, Paper No. [illegible]

[illegible], PTO-413

[illegible]

Notice of [illegible], PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

1. Part III: Detailed Office Action

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1647.

2. *Formal Matters:*

The amendment dated 6-30-2000 has canceled all previous claims and attempted to add claims 24-47, however, the last claim number in the application prior to this amendment was claim 28. Thus, all of the claims of the amendment dated 6-30-2000 have been re-numbered as 29-52 by Rule 1.26. Any subsequent/future amendment to these claims should be done using the properly re-numbered claims

The indicated allowability of the prior claims, which are represented by new claims 29-52 is withdrawn in view of the newly discovered reference(s) to Flanagan et al. Rejections based on the newly cited reference(s) follow.

3. *Art Rejection*:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 29-52 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Flanagan et al.

The art to Flanagan et al disclose and/or claim the nucleic acid and amino acid sequence for a protein that they refer to as EPH, which is functionally similar or considered the same as the proteins that applicants refer to as LERK-6 based on a comparison of their sequences (see claims and sequences). This art discloses the mouse and chicken sequences for their EPH protein, and teach that six samples of genomic DNA was subjected to restriction enzymes from genomic Southern blots of both mouse and human cDNA (Ex 6, 12). The mouse and chicken forms of these proteins were shown to be 72% identical, and a degenerate template for preparing other specie forms of this protein was prepared from the alignment of mouse and chicken EPH (col 30, ol. 63). Further teach is how to prepare antibodies to these various specie forms of the EPH protein can be prepared (col 33-26).

In the express absence of anticipation, in which there are minor differences in the claimed and prior art sequences, the above cited teachings appear to anticipate or render obvious the instant claims, despite the fact that the proteins are referred to by different names. Accordingly, the burden is upon applicant's to establish a patentable difference (In re Best 195 USPQ 430).

Advisory Information:

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Garnette D. Draper, Art Unit 1647, whose telephone number is (703)**

308-4232. Examiner Draper can normally be reached Monday through Friday, 9:30 A.M. to 6.00 P.M.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at telephone number (703) 308-0196.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED** so as to avoid the processing of duplicate papers in the Office.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294 **Please** advise the Examiner at the telephone number above when an informal fax is being transmitted

DRAPER
EXAMINER
1800

GARNETTE D DRAPER
PRIMARY EXAMINER
GROUP 1800